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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,686	04/15/2004	Heikki Olavi Haapiainen	2006978-0018	8865

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CHOATE, HALL & STEWART LLP
Patent Department
Two International Place
Boston, MA 02110

EXAMINER

SPAHN, GAY

ART UNIT	PAPER NUMBER
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3635

MAIL DATE	DELIVERY MODE
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12/12/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/825,686	HAAPIAINEN, HEIKKI OLAVI	
	Examiner	Art Unit	
	Gay Ann Spahn	3635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 April 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) _____ is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) 1-46 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Election/Restrictions - Restriction Requirement

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-26, drawn to a room-bounding structure, classified in class 52, subclass 796.1.
- II. Claims 27-33, drawn to a modular room for a building, classified in class 454, subclass 237.
- III. Claims 34-46, drawn to a structural system for forming at least part of a room-bounding structure, classified in class 52, subclass 302.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the room-bounding structure (i.e., combination) does not require perforated conduit (i.e., particulars of subcombination or structural system for forming at least a part of a room-bounding structure). The subcombination has separate utility such as can be used as a separate substrate.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are

subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because modular room (i.e., combination) does not require perforated conduit ((i.e., particulars of subcombination or structural system for forming at least a part of a room-bounding structure). The subcombination has separate utility such as can be used as a separate substrate.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if

any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the modular room (i.e., combination) as claimed does not need the spacer protrusion (i.e., particulars of subcombination of room-bounding structure). The subcombination has separate utility such as can be used a separate substrate.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such

claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because any one of: (1) the inventions have acquired a separate status in the art in view of their different classification, (2) the inventions require a different field of search (see MPEP § 808.02), (3) the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Election/Restrictions - Election of Species Requirement

This application contains claims directed TWO GROUPS OF SPECIES from each of which Applicant must elect a single species.

The FIRST GROUP OF SPECIES (i.e., species of wall structure) from which Applicant must elect a single species is:

GROUP I, SPECIES I - Fig. 1;

GROUP I, SPECIES II - Fig. 2;

GROUP I, SPECIES III - Fig. 3;

OR

GROUP I, SPECIES IV - Fig. 4.

The species are independent or distinct because:

GROUP I, SPECIES I (i.e., Fig. 1) discloses one wall structure;

GROUP I, SPECIES II (i.e., Fig. 2 discloses two wall structures

GROUP I, SPECIES III (i.e., Fig. 3) discloses a wall structure including wood paneling; and

GROUP I, SPECIES IV (i.e., Fig. 4) discloses a wall structure including insulation.

The SECOND GROUP OF SPECIES (i.e., species of ventilated two-wall and floor structural assembly) from which Applicant must elect a single species is:

GROUP II, SPECIES I - Fig. 6;

OR

GROUP II, SPECIES II - Fig. 12.

The species are independent or distinct because:

GROUP II, SPECIES I (i.e., Fig. 6) discloses walls and a floor having collection ducts and distribution ducts, respectively, therein; and

GROUP II, SPECIES II (i.e., Fig. 12) discloses walls and a floor having perforated pipe embedded in the casted structures forming the walls and floor.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species from each of the two groups of species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, at least independent claim 1 appears to be generic to the first group of species.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected from each group of species consonant with this requirement, and a listing of all claims readable upon each elected species of each group of species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.
MPEP § 809.02(a).

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because any one of: (1) the inventions have acquired a separate status in the art in view of their different classification, (2) the inventions require a different field of search (see MPEP § 808.02), (3) the inventions have acquired a separate status in the art due

to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call to Applicants to request an oral election to the above restriction requirement was not made due the complexity of the election.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gay Ann Spahn whose telephone number is (571)-272-7731. The examiner can normally be reached on Monday through Friday, 10:30 am to 7:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard E. Chilcot can be reached on (571)-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Gay Ann Spahn

Gay Ann Spahn, Patent Examiner
December 10, 2007